



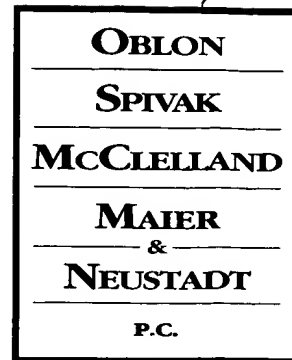
Docket No.: 192403US55X

"RESPONSE UNDER 37 CFR 1.116-  
EXPEDITED PROCEDURE EXAMINING  
GROUP 3721"

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/584,182  
Applicants: David SUDA, et al.  
2<sup>nd</sup> RCE Filed: March 3, 2003  
For: APPARATUS AND METHOD  
FOR BAGGING AN ITEM  
Group Art Unit: 3721  
Examiner: HARMON, C.

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SIR:

Attached hereto for filing are the following papers:

TECHNOLOGY CENTER R3700

**Request for Reconsideration (After Final)**

Our check in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Jean-Paul Lavalleye

Registration No. 31,451

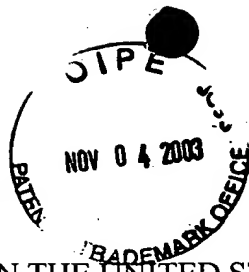
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"RESPONSE UNDER 37 CFR 1.116-  
EXPEDITED PROCEDURE EXAMINING  
GROUP 3721"

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

# 29  
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IN RE APPLICATION OF: :  
David SUDA, et al. : EXAMINER: HARMON, C.  
SERIAL NO: 09/584,182 :  
2<sup>nd</sup> RCE FILED: March 3, 2003 : GROUP ART UNIT: 3721  
FOR: APPARATUS AND METHOD :  
FOR BAGGING AN ITEM :

REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS  
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SIR:

In response to the Official Action August 12, 2003, the Applicants respectfully request favorable reconsideration of the above-identified application in light of the following discussion.

Claims 1 and 3-8 are presently active in this case.

In the outstanding Official Action, Claims 1 and 3-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson (GB 448,519) in view of Buchman et al. (U.S. Patent No. 5,020,302). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejection.

Independent Claims 1, 3, and 4 each recite a method for inserting an item into a receptacle using an apparatus having a hollow cylindrical tube section and a hollow flared section. The methods recite the steps of positioning a receptacle over an exterior surface of

the cylindrical tube section, inserting the item within the flared section, and sliding the item through a narrow opening in the flared section, through the cylindrical tube section, and within the receptacle. The Applicants submit that no motivation is present to combine the teachings in the cited references to arrive at the claimed present invention recited in independent Claims 1, 3, and 4 of the present application.

The Robinson reference describes a method of packing mattresses in bags or other containers. In the method described in the Robinson reference, the article is rolled into a coiled form, and then the coiled article is inserted into one end of a tube to retain its coiled form and the article is pushed through the tube into a bag or container, which is located over the other end of the tube. During a discussion of the background of the invention, the Robinson reference states that it is customary to wrap mattresses in cloth or paper sheets by rolling them in with such sheet. The Robinson reference notes that a rolled mattress is extremely difficult to insert in a paper bag and if the mattress is previously tied then the package remain loose within the paper bag. (See page 1, lines 12-22.) Thus, the Robinson reference teaches the use of the tube described therein which prevents the mattress from unrolling while it is entering the bag. (See page 2, lines 28-30.)

The Buchman et al. reference describes a problem similar to that described in the Robinson reference. The Buchman et al. reference describes problems associated with inserting a roll of plastic bags into a packaging carton. The Buchman et al. describes one method of inserting the rolled bags by manually inserting the bags, however such a method decreases the number of packages that can be formed in a given time (presumably due to human inefficiencies) and increases the total cost. The Buchman et al. reference then describes a second method in which a machine is used to grip the outside of the roll of bags and automatically insert the roll into a carton. However, the Buchman et al. reference

indicates that a disadvantage of the second method is that the carton must necessarily be sufficiently large to accommodate the roll and the gripper mechanism so that the gripper can hold the roll until the roll is inside the carton, where the gripper then releases it. The Buchman et al. reference notes that because the size of the carton must be overly large, more material must be used to form the carton, thus increasing the total cost of the carton, as well as increasing the space needed to transport and store the cartons. (See column 1, lines 9-34.)

Thus, the Buchman et al. reference teaches a method of inserting a roll of material into a carton that does not include a gripping mechanism that grips the outside of the roll. The method of the Buchman et al. reference a method of inserting a roll of material into a carton by gripping an inside of the roll and drawing the roll into the carton where the roll is released by the gripping mechanism. The Buchman et al. reference describes a rotating device (126) that rotates the spindle (122) in the required direction to wind up the tail (142) of the roll (14) while the spindle (122) is being retracted, pulling the roll (14) into the carton (150). (See column 3, lines 57-60.)

The Buchman et al. reference teaches away from the use of a device on the outside of the rolled item during insertion of the item into the carton, since the use of such a device would necessarily increase the size of the carton, thus increasing the cost of the carton and increasing the space needed to transport and store the carton. Thus, the Buchman et al. reference clearly teaches away from the use of a metal tube (1) as described in the Robinson et al. reference. The metal tube (1) of the Robinson reference would necessarily increase the size of the carton needed to receive the roll, thus increasing the cost of the carton and increasing the space needed to transport and store the carton, which is directly contrary to the teachings of the Buchman et al. reference.

Furthermore, the Robinson reference indicates that the method described therein solves the problems associated with previous insertion manners, thus the addition of the device described in the Buchman et al. reference would be unnecessarily costly and complex. The Robinson reference implies that it provides a method that inserts a rolled item in a bag in a manner such that the outer surface is smooth and in an efficient manner, thus there is no need for the complex and costly device described in the Buchman et al. reference. The Robinson reference uses a simply ram to insert the rolled item into the bag. Such a ram would be ineffective in providing a rotation to the item as it is being inserted within the bag.

Thus, the Applicants submit that no motivation existed, prior to the present invention, for combining the teachings of the Robinson reference and the Buchman et al. reference.

The Applicants respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejections of Claims 1, 3, and 4.

Application Serial No.: 09/584,182  
Reply to Office Action dated August 12, 2003

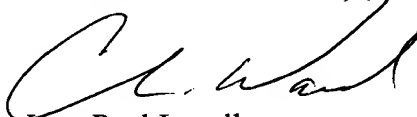
Claims 5-8 are considered allowable for the reasons advanced for Claim 1 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 1.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

If the Examiner believes that the above amendment does not place the application into condition for allowance, and if the Examiner believes that the prosecution of the present application can be furthered through a discussion with Applicants' representative, then the Examiner is hereby requested to contact Applicants' representative, Christopher Ward, at (703) 412-6228.

Respectfully Submitted,

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